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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,740	02/27/2004	James C. Vanous	86193SLP	8410
7590	10/14/2005			
			EXAMINER	
			CHEA, THORL	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/789,740	VANOUS ET AL.
	Examiner Thori Chea	Art Unit 1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 July 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 16-18 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02272004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This office action is responsive to the communication on July 18, 2005; claims 1-18 are pending in this instant application; claims 16-18 are withdrawn from consideration as being drawn to non-elected invention.
2. Applicant's election without traverse of claims 1-15 in the reply filed on July 18, 2005 is acknowledged.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification disclosure fails to provide an adequate written description as how to produce a photothermographic material when thermally produced provide an area disposed along a length of at least one edge of the photothermographic material, the area having an optical density less than the D<sub>max</sub> and greater than the D<sub>min</sub> of the photothermographic material.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. The invention as claimed is unclear with respect to claimed photothermographic material, i.e., the material before thermally processed or the material after thermally processed. See the language "an area disposed along a length of at least one edge of the photothermographic material, the area having an optical density less than the Dmax and greater than the Dmin of the photothermographic material". This limitation is unclear whether one edge of the photothermographic material, the area having an optical density less than the Dmax and greater than the Dmin of the photothermographic material depends on the photothermographic material before processing or this property is obtained through the thermally processing. The antecedent basis for "the Dmax" and "the Dmin" is unclear since the term "Dmax" and "Dmin" has not been previously stated. Moreover, the comparative "the area having an optical density less than the Dmax and greater than the Dmin" is vague and indefinite. The specification fails to clearly provide the mete and bound of Dmin, Dmax or the difference thereof.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shoji (US Patent No. 6,569,614).

See photothermographic material that having Dmin and Dmax after thermally processing. See Figs. 3-6 on sheet 2-3 and Dmin and Dmax in column 8, lines 17-67, wherein  $D_{min} \leq 0.25$  and  $D_{max} \geq 2.5$ , and Fig. 6 which discloses a region that has density less than Dmax and greater than Dmin. Shoji et al may not disclose whether an area disposed along a length of at least one edge of the photothermographic material, the area having an optical density less than the Dmax and greater than the Dmin of the photothermographic material as claimed. However, this area is inherent to the photothermographic material taught in Shoji that inherently produce the density Dmin, Dmax and an area having density between Dmin and Dmax. Therefore, the area disposed along a length of at least one edge of the photothermographic material, the area having an optical density less than the Dmax and greater than the Dmin of the photothermographic material as claimed is inherent to the material and the process taught in Shoji. In the absence of showing in the contrary, it is asserted that the invention as claimed is either anticipated by or would have been found *prima facie* obvious over the disclosure of Shoji.

10. Claims 1-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0600586B1 (EP'586).

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See EP'586 as a whole especially the samples in Tables 1-7 on pages 9-22; pages 2, lines 34-57 to page 3, lines 1-20, and page 12, example 28 wherein the protective topcoat layer containing isocyanate; and the binder on pages 7, liners 49-54 including methacrylate copolymers. EP'586 may not disclose whether an area disposed along a length of at least one edge of the photothermographic material, the area having an optical density less than the Dmax and greater than the Dmin of the photothermographic material as claimed. However, this area is inherent to the photothermographic material taught in EP'586 that inherently produce the density Dmin, Dmax and an area having density between Dmin and Dmax. Therefore, the area disposed along a length of at least one edge of the photothermographic material, the area having an optical density less than the Dmax and greater than the Dmin of the photothermographic material as claimed is inherent to the material and the process taught in EP'586 due to the similarity of the composition and inherently produce Dmin and Dmax. In the absence of showing in the contrary, it is asserted that the invention as claimed is either anticipated by or would have been found *prima facie* obvious over the disclosure of EP'586.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tch  
September 26, 2005

*Thorl Chea*  
Thorl Chea  
Primary Examiner  
Art Unit 1752